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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,025	11/20/2006	Stephen Behr	41313-1004	2195
69849 7590 03/20/2009 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 990 Marsh Road Menlo Park, CA 94025				
EXAMINER				
MI, QIUWEN				
ART UNIT		PAPER NUMBER		
1655				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,025

**Applicant(s)**

BEHR ET AL.

**Examiner**

QIUWEN MI

**Art Unit**

1655

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26 and 30-60 is/are pending in the application.
- 4a) Of the above claim(s) 34, 36-44, 59 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26, 30-33, 35 and 45-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/14/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### CONTINUED EXAMINATIONS

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/14/09 has been entered.

Applicant's amendment in the reply filed on 1/14/09 is acknowledged, with the cancellation of Claims 1-25, and 27-29; and the additional newly added Claims 59 and 60. Claims 26, and 30-60 are pending.

Newly submitted claims 59 and 60 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented claims and newly submitted claims 59 and 60 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Kondo et al (JP 2000336024A) teach the technical feature of *Chenopodium quinoa* seeds (see details in the 103 rejection below), therefore, there is no special technical feature in the application. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1., and therefore lack of unity of invention exists.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 59 and 60 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 34, 36-44, 59, and 60 are withdrawn as they are directed toward a non-elected invention groups or species. **Claims 26, 30-33, 35, and 45-58 are examined on the merits.**

The 112, 1<sup>st</sup> rejection is hereby withdrawn due to Applicant's amendment by deleting "preventing".

### **Specification Objections**

The disclosure is objected to because of the following informalities: The specification recites "novel" on page 10. It is suggested that the term "novel" be deleted from the language of the specification. Once the determination of the novelty of a claimed invention has been established and the disclosure of the invention made public and/or patented, the claimed invention is no longer novel or new, since the scope of the invention no longer embraces what is considered "novel". Thus, the incorporation of the term "novel" into the language of the specification is not appropriate. Correction is required.

### **Claim Objections**

Claims 26, 30-33, 35, and 45-58 are objected to because of the following informalities:

Claim 26 recites "one or more plant extracts modulates..." in line 6, which is grammatically incorrect. The correct recitation should be "one or more plant extracts modulate...".

All other cited claims depend directly or indirectly from objected claims and are therefore, also, objected for the reasons set forth above.

**Claim Rejections –35 USC § 112, 2<sup>nd</sup>**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26 (line 3) and 30 (line 2) recite improper Markush groups, “selected from the group of...”. The correct recitation should be “selected from the group consisting of...”.

Claims below recite the following limitations and there are insufficient antecedent basis for these limitations in the claims:

“the activity” in claim 26, line 3;

“the appearance” in claim 47, lines 1 and 3; and claim 54, line 2;

“the onset of skin ageing” in claims 48 and 49, lines 1-2.

Therefore, the metes and bounds of claims are rendered vague and indefinite. The lack of clarity renders the claims very confusing and ambiguous since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

All other cited claims depend directly or indirectly from objected claims and are, therefore, also, objected for the reasons set forth above.

**Claim Rejections –35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 30-33, 35, and 45-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al (JP 2000336024A) in view of Cyr (US 2004/0175439).

Kondo et al teach cosmetic (dermatological) compositions containing one or more humectant plant extracts of *Chenopodium quinoa* etc for dry skin (see Abstract). Kondo et al teach a sample preparation of lotion (thus topical, administering to a subject) comprising purified water (physiologically acceptable carrier), polyethylene glycol 1000 (moisturizing agent), and Quinoa (the same as *Chenopodium quinoa*, see page 4, [0008]) in 20% EtOH extract (thus solvent extraction) (alcoholic solvent) (see full translation, page 27, [0085]). Kondo et al also teach that composition of cosmetics that contain moisture-retaining plant extracts with sustained moisture-retention effects over extended periods, and possess properties effective for skin treatments that prevent, alleviate, or improve such conditions as dryness, rough skin, cracks, chaps, dandruff, pruritus and inflammatory diseases (thus maintain and/or improve the health and/or appearance of the skin in a subject) (see page 32, [0100]). Kondo et al further teach Quinoa extract in 30% PG (propylene glycol, see page 24, [0074]) in test solutions (see page 26, Table 2). Kondo et al at last teach the plants used in this invention are described as follows,

wherein the preparation is performed with the leaf, stem, root, flower, seed or whole plant, which may also come in the form of crude drugs (page 4, [0007]).

Kondo et al do not teach the plant material from *Chenopodium quinoa* has the matrix metalloprotease inhibiting activity, neither do Kondo et al explicitly teach using *Chenopodium quinoa* seed.

Cyr teaches plant extracts and compositions comprising extracellular protease inhibitors (see Title). As evidenced by Cys, *Chenopodium quinoa* has 66.3% MMP-1 inhibition (page 16, Table 1), 92% MMP-2 inhibition (page 20, Table 2 , and 23.1-34.7% MMP-9 inhibition (page 33, Table 4).

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the extract of *Chenopodium quinoa* in a method of improving the appearance of skin, delaying the onset of aging, or delaying the dermatological condition such as inflammation since Kondo et al teach the plant extract with sustained moisture-retention effects over extended periods, and possess properties effective for skin treatments that prevent, alleviate, or improve such conditions as dryness, rough skin, cracks, chaps, dandruff, pruritus and inflammatory diseases. It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use a dermatological formulation comprising plant extract from *Chenopodium quinoa* that inhibit the activity metalloprotease since Cyr teaches *Chenopodium quinoa* has 66.3% MMP-1 inhibition activity, 92% MMP-2 inhibition activity, and 23.1-34.7% MMP-9 inhibition activity. It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use *Chenopodium quinoa* seed since Kondo et al at last teach the preparation of plants used in this invention is performed with

the leaf, stem, root, flower, seed or whole plant. Choosing from a finite number of predictable solutions would have been obvious because a person of ordinary skill has good reason to pursue the known options with his or her technical grasps. If this leads to the anticipated success, it is likely that the product is not of innovation, but of ordinary skill and common sense.

Since the composition of Kondo et al yielded beneficial results in cosmetic industry, one of ordinary skill in the art would have been motivated to use the composition from Kondo et al.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant's arguments with respect to reference Kondo et al and Diot have been considered but are moot in view of the new ground(s) of rejection in view of Cyr.

### **Conclusion**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Qiuwen Mi/

Examiner, Art Unit 1655